

REMARKS

Claims 2-4, 6 and 7 are pending. No amendments have been made by way of the present submission, thus, no new matter has been added.

Rejections Under 35 U.S.C. § 103(a)

Claims 2-4, 6 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamazaki et al., EP 0791688 (hereinafter, “Yamazaki et al.”). (*See*, Office Action of August 9, 2007, at pages 3-5, hereinafter, “Office Action”). Applicants traverse the rejection as hereinafter set forth.

The Examiner states, at the bottom of page 3 of the Office Action, that the present application contains “product by process” claims. However, the present application clearly does not contain any such claims. All of claims 2-4, 6 and 7 are composition claims. The Examiner seems to believe claim 7 recites an active step, the step being “decreasing the surface layer calcium carbonate.” (*Id.* at page 5). However, claim 7 recites no such step. Claim 7 recites absolutely no active steps anywhere in the claim. Claim 7 recites the following:

A wrapper paper for a smoking article, which decreases an amount of visible sidestream smoke of tobacco, the wrapper paper containing:
at least 30 g/m² of calcium carbonate, and
at least 3% by mass of a burn adjusting agent,
wherein the amount of calcium carbonate in a surface layer on each of a top side and a bottom side of the wrapper paper is decreased while keeping the amount of calcium carbonate contained within the wrapper paper.

Although claim 7 may recite “keeping,” it is clearly understood from the claim language that this term is in relation to the term “amount of calcium carbonate” and merely indicates that the total amount of calcium carbonate in the wrapper paper is maintained as indicated in the first

limitation “at least 30 g/m² of calcium carbonate,” while the relative amount of calcium carbonate on the surface layers is less than the amount in the rest of the paper. In other words, the amount (concentration) of calcium carbonate inside the paper is greater than the amount (concentration) in the top and bottom surface layers. This is clear from the simple language of claim 7, the meaning of which has not been questioned. The Examiner’s interpretation of this phrase, or any other phrase within the pending claims, as an active step or as indicating a product by process claim is entirely inconsistent with the clear and simple language of the presently pending claims. Thus, the Examiner is referring to limitations that are literally not present anywhere in the claims.

The Examiner additionally states that the claimed ash content characteristics are either inherent or obvious based on the fact that Yamazaki et al. disclose a paper having essentially the same composition. In this regard, it is noted that “ash content” corresponds to “calcium carbonate content,” as supported by the present specification and as is known to one of ordinary skill in the art. However, the Examiner is again improperly interpreting the claims. The claims do not merely require the two limitations of “at least 30 g/m² of calcium carbonate, and at least 3% by mass of a burn adjusting agent” and a result that naturally flows from these first two limitations. Rather, as is clearly recited in independent claim 6, two additional limitations are required, as follows:

wherein the percentage of ash content in a surface layer on each of a top side and a bottom side of the wrapper paper is lower than a total ash content in percentage of the wrapper paper, and

wherein the ash content in the surface layer on each of the top side and the bottom side of the wrapper paper is not higher than 30% by mass.

These two additional limitations are not merely resultant properties of the first two limitations. Clearly, these two additional limitations instruct where exactly in the paper, and by what proportions, the ash content of the wrapper paper is contained. Therefore, the Examiner's presumption that the first two limitations of claim 6, or claim 7, necessarily results in the outcome provided by the second two limitations is unsupportable. The ash content of wrapper papers may be in any number of configurations or quantities anywhere within the wrapper paper.

In fact, Yamazaki et al. is entirely silent as to where, within the wrapper paper, the ash content is to be distributed.

As described in the present specification, at page 9, lines 3-8, when a paper internally comprises a loading material (calcium carbonate) and is manufactured by a conventional Fourdrinier machine, the amount of the loading material on the wire side is rendered smaller than that on the felt side in accordance with the dehydration from the wire side in the paper layer-forming stage. As a result, the calcium carbonate content of the resulting paper is naturally smaller on the wire side than on the felt side, and the calcium carbonate content is naturally higher than the total calcium carbonate content in percentage of the paper. As further described in the present specification, at page 11, lines 2-12, the paper manufactured by the conventional Fourdrinier machine has the highest loading material (calcium carbonate) content on the felt surface, and the loading material content is gradually lowered toward the wire surface.

In contrast, in the presently claimed invention, as described in the present specification, at page 10, lines 8-14, a double-sided dehydration type wire part is used to establish that the percentage of ash content in a surface layer on each of a top side and a bottom side of the wrapper paper is lower than a total ash content in percentage of the paper. This clearly indicates

to one of ordinary skill in the art that the total ash content is higher internally within the wrapper paper, and lower on the upper and lower surfaces of the wrapper paper.

Yamazaki et al. do not disclose or suggest using a double-sided dehydration type wire part to make its wrapping paper. Thus, the presently claimed invention is not inherent in or obvious from Yamazaki et al. because Yamazaki et al. do not disclose or suggest all of the limitations of the presently pending claims. In view of the above, the Examiner has not established a *prima facie* case of inherency or obviousness and the rejection must be withdrawn.

Therefore, reconsideration and withdrawal of the obviousness rejection of claims 2-4, 6 and 7 are respectfully requested.

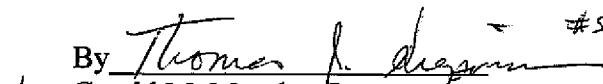
CONCLUSION

If the Examiner has any questions or comments, please contact Thomas J. Siepmann, Ph.D., Registration No 57,374, at the offices of Birch, Stewart, Kolasch & Birch, LLP.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

Dated: February 8, 2008

Respectfully submitted,

By  #57374
Gerald M. Murphy, Jr.
Registration No.: 28,977
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicants